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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,029	09/16/2003	William Waycott	20612.002/P30632US01	4492
<div>28381 7590 01/23/2008</div> <div>ARNOLD & PORTER LLP</div> <div>ATTN: IP DOCKETING DEPT.</div> <div>555 TWELFTH STREET, N.W.</div> <div>WASHINGTON, DC 20004-1206</div>				
			<div>EXAMINER</div> <div>ROBINSON, KEITH O NEAL</div>	
			<div>ART UNIT</div> <div>1638</div>	<div>PAPER-NUMBER</div>
			<div>MAIL DATE</div> <div>01/23/2008</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,029	Applicant(s) WAYCOTT, WILLIAM	
	Examiner Keith O. Robinson, Ph.D.	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9 and 38-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 38-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>20071004</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action mailed May 3, 2007 and the following **second non-final** Office Action is set forth. Applicant's amendment of claims 1, 38, 41, 43-45, 48 and 56 and cancellation of claims 3, 4 and 10-37, filed November 5, 2007, have been received and entered in full.

Claims 1, 2, 5-9 and 38-56 are under examination.

Response to Arguments

Applicant's arguments, see page 15, 1st paragraph to page 16, last paragraph of 'Remarks' filed November 5, 2007, with regards to the 35 USC 103 rejection of claims 1, 5 and 7 on pages 6-7 of the Office Action mailed May 3, 2007, have been fully considered and found persuasive. The rejection has been withdrawn.

Applicant's arguments, see page 17, 1st paragraph to page 18, lines 1-4 of 'Remarks' filed November 5, 2007, with regards to the 35 USC 103 rejection of claim 1 on pages 7-8 of the Office Action mailed May 3, 2007, have been fully considered and found persuasive. The rejection has been withdrawn.

Claim Rejections - 35 USC § 112, first paragraph – Written Description

Claims 1, 2, 5-9, 46-48 and 51-56 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed May 3, 2007, as applied to claims 1-3, 5-9, 46-48 and 51-56 (see pages 3-5). Applicant's arguments, filed November 5, 2007, have been fully considered but are not persuasive.

Applicant argues that the specification reflects Applicant's possession of the claimed invention (see page 7, 2nd to page 9, 2nd full paragraph of 'Remarks' filed November 5, 2007).

This is not persuasive. Applicant is attempting to claim any and all iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B; however, Applicant has only shown possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

See MPEP 2163(I) where it states "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116".

The specification only provides evidence that Applicant was in possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 and not each and every iceberg lettuce cultivars having an elliptical stature and comprising a

first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B as is broadly claimed.

Also see MPEP 2163.02 where it states, “[a]n objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)”.

In the instant invention, one of ordinary skill in the art would only recognize that Applicant has only invented breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 and not each and every iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B as is broadly claimed.

Thus, based on the disclosure of the specification, Applicant has only shown possession of breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 and not each and every iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B as is broadly claimed.

Applicant argues that the claimed invention of claims 41-45 and 49-55 is described (see page 9, 3rd paragraph to page 10, 1st paragraph of ‘Remarks’ filed November 5, 2007).

The Examiner is unclear why Applicant is arguing claims that were not rejected in the Office Action mailed May 3, 2007 (i.e. claims 41-45, 49 and 50). However, with

regards to claims 51-55, which are dependent on claim 48, the Examiner maintains the rejection of these claims for the reasons cited above (i.e. lack of possession of the claimed invention).

Claim Rejections - 35 USC § 112, first paragraph - Enablement

Claims 1, 2, 5-9, 46-48 and 51-56 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032, does not reasonably provide enablement for all iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The rejection is repeated for the reasons of record as set forth in the Office Action mailed May 3, 2007, as applied to claims 1-3, 5-9, 46-48 and 51-56 (see pages 5-6). Applicant's arguments, filed November 5, 2007, have been fully considered but are not persuasive.

Applicant argues that it is improper to conclude that a disclosure is not enabling based on an analysis of only one Wands factor while ignoring one or more of the others (see page 11, 1st paragraph of 'Remarks' filed November 5, 2007).

This is not persuasive. MPEP 2164.01 states, "[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the

disclosures in the patent coupled with information known in the art without undue experimentation." In the instant case, one skilled in the art would only be able to make and use lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 based on the disclosure of the specification because the specification only provides working examples for how to make and use lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032. MPEP 2164.02 states, "[l]ack of a working example...is a factor to be considered, especially in a case involving an unpredictable and undeveloped art". The creation of new varieties is unpredictable as stated in the specification. See page 5, paragraph 00023, where it states, "[a] common problem in the creation of new varieties is the desired genetic phenotype in a large population...[because] more than 10,000 genes [are] known to exist in plants, it is often highly improbable, if not impossible to converge on all the desired genetic traits in one individual". In addition, the specification only provides guidance for how to make and use lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Thus, based on the evidence of provided in the specification for guidance for lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032, working examples of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032, the unpredictability in the art in creating new varieties with desired characteristics and the breadth of the claims, it would require undue trial and error experimentation for one skilled in the art to make and use the claimed invention. One skilled in the art would only be able to make and use lettuce breeding lines PSR 4569,

PSR 4570, PSR 6425, PSR 6595 and PSR 6032 based on the disclosure of the instant specification.

Applicant argues that the specification discloses how to make and use the claimed invention (see page 11, last paragraph to page 12, lines 1-7 of 'Remarks' filed November 5, 2007).

This is not persuasive. The specification only provides guidance for how to make and use lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 as stated above.

Applicant argues that the Examiner has provided either evidence supporting the rejection nor any explanation of why the specification fails to enable the claimed invention (see page 12, 1st full paragraph of 'Remarks' filed November 5, 2007).

This is not persuasive. See pages 5-6 of the Office Action mailed May 3, 2007 as well as the above arguments.

Applicant argues that the specification enables the method claims of claims 8 and 9 (see page 12, 2nd full paragraph to page 13, lines 1-7 of 'Remarks' filed November 5, 2007).

This is not persuasive. The claims are broadly drawn to crossing any iceberg lettuce with any romaine lettuce to produce an iceberg lettuce having a first outer leaf having a length to width ratio between 1.2 to about 2.7. The specification only provides guidance for making lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 using specific lettuce varieties as parental material. See, for example, page 10, paragraph 00048 where it states that lettuce breeding line PSR 4569 was

produced by crossing 'PI 206964' with 'Salinas 88'. One skilled in the art would understand that the claimed characteristics would not exist in each and every iceberg lettuce plant and romaine lettuce plant and that by crossing any iceberg lettuce with any romaine lettuce would not always produce a lettuce plant having a first outer leaf having a length to width ratio between 1.2 to about 2.7.

Applicant argues that the choice to employ lines PSR 6425, PSR 6595 and PSR 6032 as opposed to other lettuce lines to produce the claimed lettuce plants is not relevant to the enablement inquiry (see page 13, 2nd full paragraph to page 14, lines 1-5).

This is found persuasive; however, the rejection of the above claims regarding scope of enablement is maintained.

Claims 38-40 remain rejected and claims 41-45, 49 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed May 3, 2007 (see page 6). Applicant's arguments, filed November 5, 2007, have been fully considered but are not persuasive.

Applicant argues that the claims do not require separating or identifying seeds and that if one chooses to separate the seeds from the lines deposited, the specification

indicates that of the three varieties only one has black seed and the other two varieties can be identified by growing plants and determining their phenotypic characteristics (see page 14, 2nd full paragraph of 'Remarks' filed November 5, 2007).

This is not persuasive. Though one would be able to distinguish the black seeded line from the white seeded lines, one would not be able to distinguish the two white seeded lines until after growing plants from both of the white seeded lines. In addition, since the claimed seeds and plants of claims 38-40 are not enabled, any seed or plant produced from said seeds and plants would not be enabled (i.e. the seeds and plants of claims 41-45, 49 and 50).

Claim Rejections - 35 USC § 103

Claims 1, 2, 5-7, 46-48 and 51-56 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Miltz (U.S. Patent No. 5,220,113, June 15, 1993), in view of Tillge (Seed Sci. & Technol. 12: 919-933, 1984), further in view of Bassett (J. Amer. Soc. Hort. Sci. 100(2): 104-105, 1975). The rejection is repeated for the reasons of record as set forth in the Office Action mailed May 3, 2007, as applied to claims 1-3, 5-7 and 41-56 (see pages 8-10). Applicant's arguments, filed November 5, 2007, have been fully considered but are not persuasive.

Applicant argues that the Miltz does not teach or fairly suggest an iceberg lettuce comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about 146B and that Tillge and Bassett alone or in combination cannot make up for the deficiencies of Miltz and that the

Examiner (see page 19, 2nd paragraph of 'Remarks' filed November 5, 2007).

Furthermore, Applicant argues that the Examiner provides no sustainable rationale to support a rejection under 103(a) (see page 19, 3rd paragraph to page 20, lines 1-2 of 'Remarks' filed November 5, 2007).

This is not persuasive. On pages 8-10 of the Office Action mailed May 3, 2007, the Examiner has provided reasons why one of ordinary skill in the art would combine the cited references as well as how Tillge and Bassett make up for the deficiencies of Miltz in addition to sustainable rationale to support a rejection under 103(a). See MPEP 2141(II)(C) where it states, "[a] person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." KSR, 550 U.S. at ___, 82 USPQ2d at 1397. "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." Id. Office personnel may also take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." Id. at ___, 82 USPQ2d at 1396". In addition, KSR forecloses the argument that a **specific** teaching, suggestion or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396).

Applicant argues that the Examiner has indicated that one of ordinary skill in the art could not bridge the gap between the prior art and the claimed invention when rejecting the claims under 112 first paragraph (see page 20, 1st paragraph).

This is not persuasive. Nowhere in the 35 USC 112 first paragraph rejection in the Office Action mailed May 3, 2007 has the Examiner indicated that one of ordinary

skill in the art could not bridge the gap between the prior art and the claimed invention when rejecting the claims under 112 first paragraph and is unclear where in the previous Office Action such an indication was made.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is (571) 272-2918. The examiner can normally be reached Monday – Friday, 7:30 a.m. - 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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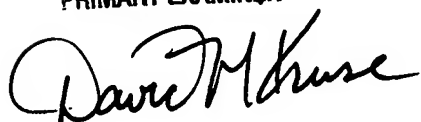
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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.
Examiner
Art Unit 1638

January 20, 2008

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse". The signature is written in a cursive, flowing style with a large initial "D".